

Remarks

This Application has been carefully reviewed in light of the Office Action mailed May 10, 2004. Applicants appreciate the Examiner's consideration of this Response. Claims 1-26 are pending in the present Application. Claim 26 is allowed; Claims 1-4, 6-7, 9-12, 14-15, 17-20, 22-23, and 25 are rejected; and Claims 5, 8, 13, 16, 21, and 24 are objected to. For at least the reasons discussed below, Applicants respectfully request reconsideration and allowance of all pending claims.

Rejections under 35 U.S.C. § 103

The Examiner rejects Claims 1-4, 6-7, 9-12, 14-15, 17-20, 22-23, and 25 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Application Publication 2002/0188528 by Adelman, et al. ("*Adelman*"). Applicants respectfully traverse these rejections and all assertions therein.

As an initial matter, Applicant notes that *Adelman* has an actual filing date (Dec. 12, 2002) that is after the filing date of the present application (Nov. 29, 2001) and therefore cannot be used to reject the claims under 102(e) or 102(e)/103 unless there is "proper support for the subject matter as required by 35 U.S.C. 119(e) or 120," in a priority document with a filing date earlier than the present application (and subject to any possible swear behind). M.P.E.P. § 706.02(f)(1), Example 2. In the present case, the provisional application relied upon for priority was not included in the initial Office Action, nor was any indication given in the Office Action of what elements in the provisional application were intended to provide "proper support for the subject matter" in the *Adelman* used in rejecting the claims. Accordingly, Applicants respectfully request that the Examiner identify the proper support for the subject matter relied upon. If there is no such support in the provisional application dated March 29, 2001, the Office Action rejects the claims based solely on material filed in the PTO after the filing date of Applicant's application.

Even if the provisional application does provide support for the portions of *Adelman* used in the rejections, the rejections would nevertheless be improper because that publication does not teach each and every limitation of the claims. For example, Independent Claim 1 recites, "in response to identifying the one or more second part numbers associated with the item, searching a database for a third part number that is associated with the item and also cross-referenced to at least one second part number associated with the item, the third part

number associated with the item being defined according to a third part numbering scheme, the first part number associated with the item being mapped to the third part number associated with the item through the at least one second part number associated with the item.” For the teaching of this limitation, the Examiner offers a passage in *Adelman* that teaches automatically mapping internal part numbers to manufacturer part numbers. Page 2, Paragraphs 20-21. In particular, the Examiner states that the passage teaches “automatically mapping saved part numbers (more than one part numbers) when a corresponding manufacturer part number becomes known.” Office Action, Page 3. But Applicants submit that the Office Action fails to consider each and every word of Claim 1. “All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03 (citing *In re Wilson*, 424 F.2d 1382, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)). In judging the patentability of Claim 1, the Office Action fails to consider at least the phrase “the first part number associated with the item being mapped to the third part number associated with the item through the at least one second part number associated with the item.” More particularly, the Office Action fails to consider at least the phrase “through the at least one second part number associated with the item.”

Adelman merely teaches directly mapping between internal part numbers and manufacturer part numbers. Page 4, Paragraph 48; Page 2, Paragraphs 20-21. Even assuming for the sake of argument that the passage cited by the Examiner teaches mapping a single internal part number to multiple different manufacturer part numbers as asserted by the Examiner, *Adelman* suggest that the internal part number is mapped directly to each different manufacturer part number, not “through the at least one second part number associated with the item” as claimed. Page 4, Paragraph 48; Page 2, Paragraphs 20-21. For example, internal part number A may be mapped directly to manufacturer part number A1 and to a second manufacturer part number A2. Page 4, Paragraph 48. In this example, the system disclosed in *Adelman* would include two mappings: internal part number A to manufacturer part number A1 and internal part number A to manufacturer part number A2. Neither of these mappings are through another part number.

Alternatively, if the Examiner is asserting that it would be obvious to modify *Adelman* to include this limitation, Applicants respectfully request, to the extent the rejection of Claim 1 is based on Official Notice for the teaching of this limitation, that a reference be provided pursuant to M.P.E.P. § 2144.03 if “common knowledge” or “well known” art is

being relied on to modify the reference. If personal knowledge is being relied on, Applicants respectfully request that an affidavit supporting such facts be provided pursuant to M.P.E.P. § 2144.03. Otherwise, Applicants respectfully request reconsideration and allowance of Claim 1 and its dependents.

Independent Claims 9, 17 and 25 recite limitations that are similar, although not identical, to the limitation of Claim 1 discussed above. Therefore, these claims are allowable for reasons analogous to those discussed above in connection with Claim 1. Claims 10-12, 14-15, 18-20, and 22-23 each depend from independent Claim 9 and 17 and are thus also patentable over the cited art.

Allowed and Allowable Claims

Applicant notes and appreciates the Examiner's allowance of Claims 26 and the Examiner indication that Claims 5, 8, 13, 16, 21, and 24 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. However, Claims 5, 8, 13, 16, 21, and 24 depend from one of Independent Claims 1, 9, and 17, which Applicants respectfully submit are allowable. Accordingly, Applicants have not so amended Claims 5, 8, 13, 16, 21, and 24 at this time.

Conclusion

Applicants have made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicants respectfully request full allowance of all pending claims.

If the Examiner believes a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Brian W. Oaks, Attorney for Applicants, at the Examiner's convenience at (214) 953-6986.

Applicants believe no fee is due. However, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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A handwritten signature in black ink, appearing to be 'Brian W. Oaks', written over a horizontal line.

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